

REMARKS¹

In the Office Action, the Examiner rejected claims 1, 2, 4, 6-10, 12, 14-18, 20, and 22-30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,325,632 to Chao et al. ("Chao"), rejected claims 3, 5, 11, 13, 19, and 21 as being unpatentable over Chao in view of "A Glossary of Online Terms" by Bill Thompson ("Thompson"); and rejected claims 31-37 under 35 U.S.C. § 103(a) as being unpatentable over Chao. No claims are amended herein. Claims 1-37 remain pending in this application.

I. Rejections under 35 U.S.C. § 102(e)

Applicant respectfully traverses the rejection of claims 1, 2, 4, 6-10, 12, 14-18, 20, and 22-30 under 35 U.S.C. § 102(e) for at least the reason that Chao fails to anticipate claims 1, 2, 4, 6-10, 12, 14-18, 20, 22-30, and 38-40. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference ... [t]he identical invention must be shown in as complete detail as is contained in the . . . claim." MPEP § 2131 8th Ed. (Rev. 4), October, 2005 (internal citations omitted). Chao cannot anticipate claims 1, 2, 4, 6-10, 12, 14-18, 20, 22-30, and 38-40 because Chao fails to teach each and every element recited in claims 1, 2, 4, 6-10, 12, 14-18, 20, and 22-30.

For example, Chao fails to teach a combination including at least "receiving a query from a user," as recited in claim 1. The Examiner asserts that this element is

¹ The Office Action contains a number of statements that characterize the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

taught in Chao, stating “Chao’632 discloses ... receiving a query from the user (col. 4, lines 1-8).” Office Action, page 2. The portion cited by the Examiner, however, teaches

the user enters his user identification ... [which] can be his real name, a code name, his fingerprint or other biometric identifier. If the user is a first time user, the user can choose his user identification to be entered into the system, which can ask for his subject of interest and whether he is a student or an instructor of that subject. Chao, col. 4, lines 1-8 (emphasis added).

The cited portion merely describes a typical log-in process, and does not teach “receiving a query from the user,” as recited in claim 1. Moreover, the emphasized portion of the citation teaches that the user receives a question from the system. This cannot constitute a teaching of “receiving a query from the user,” as recited in claim 1.

In addition, Chao fails to teach “generating an identification code corresponding with said query,” as also recited in claim 1. Chao states:

the user is a student [and] [h]is characteristics again can be categorized ... includ[ing] the subject he is interested in, which in this case, is the subject he wants to learn, 352 ... after the student enters his characteristics into the system, the search engine 106 can automatically identify the instructor for the student. Chao, col. 4 line 61 - col. 5, line 20.

Chao thus teaches categorizing the student/user based on a student/user’s response to a query from the search engine and identifying a suitable instructor for the student.

Because the query of Chao is not received from the user (as also discussed above), this cannot constitute a teaching of “generating an identification code corresponding with said query [received from the user],” as recited in claim 1 (emphasis added).

Because Chao fails to teach each and every element recited in claim 1, Chao cannot anticipate claim 1. Claim 1 is thus allowable over Chao and claims 2, 4, and 6-8 are allowable at least due to their dependence from claim 1.

For analogous reasons, independent claims 9, 17, and 25-30 are also allowable. Claims 10, 12, 14-16, 18, 20, and 22-24 depend from at least one of independent claims 9, and 17, and thus are also allowable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 2, 4, 6-10, 12, 14-18, 20, and 22-30 under 35 U.S.C. § 102(e).

II. Rejections under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 3, 5, 11, 13, 19, 21, and 31-37 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must “ be found in the prior art, and not be based on applicant’s disclosure. ” See MPEP § 2143, 8th Ed. (Rev. 4), October, 2005.

In this application, no *prima facie* case of obviousness has been established for at least the reason that the cited references fail to teach or suggest each and every element recited in claims 3, 5, 11, 13, 19, 21, and 31-37.

A. Claims 3, 5, 11, 13, 19, and 21

Claims 3, 5, 11, 13, 19, and 21 depend from at least one of independent claims 1, 9, and 17, and thus require all of the elements recited in the independent claims from which they depend. As discussed above, Chao fails to teach or suggest a combination including at least “receiving a query from a user,” and “generating an identification code corresponding with said query,” as recited in independent claims 1, 9, and 17, and required by claims 3, 5, 11, 13, 19, and 21 (emphasis added). Thompson fails to cure the deficiencies of Chao.

Thompson is cited by the Examiner for allegedly teaching “the URL is industry standard for providing the server information along with websites.” Office Action, page 9. Such alleged teachings, even if combinable with Chao, fail to cure the above-noted deficiencies of Chao. That is, Thompson also fails to teach or suggest a combination including at least “receiving a query from a user,” and “generating an identification code corresponding with said query,” as recited in independent claims 1, 9, and 17, and required by claims 3, 5, 11, 13, 19, and 21 (emphasis added).

Because Chao and Thompson fail to teach or suggest every element required by claims 3, 5, 11, 13, 19, and 21, a *prima facie* case of obviousness has not been

established. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 3, 5, 11, 13, 19, and 21 under 35 U.S.C. § 103(a).

B. Claims 31-37

Independent claim 31 recites a method including, *inter alia*, “providing at least one page in a site corresponding with said contents-providing server, having at least one counseling link,” and “when said counseling link is selected by a user, generating an identification code corresponding with said counseling link.” Chao fails to teach or suggest at least these features.

Chao teaches that a “user enters his user identification ... [which] can be his real name, a code name, his fingerprint or other biometric identifier,” and that “[i]f the user is a first time user, the user can choose his user identification to be entered into the system, which can ask for his subject of interest and whether he is a student or an instructor of that subject.” Chao, col. 4, lines 1-8. Chao further teaches that if “after the student enters his characteristics into the system, the search engine 106 can automatically identify the instructor for the student.” Chao, col. 5, lines 18-20. Chao thus teaches that after the student enters information requested from the search engine, the search engine will identify a suitable match for the student. The user in Chao inputs the identification information, and from the input will be provided a match. This cannot constitute a teaching of at least “when said counseling link is selected by a user, generating an identification code corresponding with said counseling link,” as recited in claim 31 (emphasis added).

Because Chao fails to teach or suggest every element recited in claim 31, a *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests that the rejection of claim 31 under 35 U.S.C. § 103(a) be withdrawn.

Claims 32 and 33 depend from claim 31, and thus require all of the elements recited in claim 31. As discussed above, Chao fails to teach or suggest every element recited in claim 31, and thus fails to teach or suggest every element required by claims 32 and 33. Accordingly, Applicant respectfully requests that the rejection of claims 32 and 33 under 35 U.S.C. § 103(a) be withdrawn.

Claim 34, although of different scope, recites elements similar to those recited in claim 31. For example, claim 34 recites a combination including at least “receiving an identification code corresponding with a counseling link selected by a user” (emphasis added). Accordingly, for at least the reasons given above with respect to claim 31, Chao fails to teach or suggest at least this element recited in claim 34.

Because Chao fails to teach or suggest each and every element recited in claim 34, a *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests that the rejection of claim 34 under 35 U.S.C. § 103(a) be withdrawn.

Claims 35-37 depend from claim 34, and thus require all of the elements recited in claim 34. As discussed above, Chao fails to teach or suggest every element recited in claim 34, and thus fails to teach or suggest every element required by claims 35-37.

Accordingly, Applicant respectfully requests that the rejection of claims 35-37 under 35 U.S.C. § 103(a) be withdrawn.

In addition, Applicant notes that Chao is the only reference relied upon by the Examiner for this particular rejection. The MPEP sets forth that

[t]he distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made. M.P.E.P. § 706.02(IV).

The MPEP clearly instructs that, for a proper 35 U.S.C. § 103 rejection, “the reference teachings must somehow be modified in order to meet the claims.” Id. Therefore, if the Examiner applies a 35 U.S.C. § 103(a) rejection based solely on Chao, he must articulate how Chao must be modified to supposedly teach each and every claim element. The Examiner does not explain how or why Chao must be modified, other than to make a generalized allegation that “it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the use of webpages with corresponding links in to the system of Chao’632.” Office Action, pages 10-11.

Moreover, “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” MPEP § 706.02(j). The Examiner’s rejections are not properly

communicated, as there is no explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification to meet the elements of Applicant's independent claims.

The MPEP further instructs that,

[a]fter indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) *an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.* Id. (emphasis added).

In this rejection, the Examiner has not set forth "an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification." Id. Accordingly, a *prima facie* case of obviousness has not been established for this reason also. Applicant therefore respectfully requests that the Examiner withdraw the rejection of claims 31-37 under 35 U.S.C. § 103(a).


In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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Ltd. Rec. No.: L0222